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ROBERT'S MLOTKOWSKI SAFRAN & COLE, P.C.
Intellectual Property Department
P.O. Box 10064
MCLEAN, VA 22102-8064

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/814,226
Filing Date: April 01, 2004
Appellant(s): FORD ET AL.

Andrew Calderon
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/28/10 appealing from the Office
action mailed 5/07/10.

Application/Control Number: 10/814,226
Art Unit: 3711

Page 2

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The Board previously rendered a decision on this application on 3/23/09. The Board reversed giving heavy weight to the term "prefabricated" used in the preamble. Since the examiner held strong belief that the prefabrication of an apparatus was considered well known, especially since prefabricated bowling panels were art of record but not applied in the previous grounds for rejection, the examiner reopened prosecution to apply the known art.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:
7, 18-24, 26-29, 31, 32 and 35-40.

The art rejection applied to claims 1-17 and 34 in the final office action has not been sustained in for the purposes of this appeal.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

Claims 7 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

The Rejection of Claim 24 and its dependent claims under 35 U.S.C. 112, 1st Paragraph has not been sustained in view of paragraphs [0015] and [0016] of the specification. As such applicant's remarks are considered moot.

Claims 18, 19, 24, 28, 31, 32, 39 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Heddon 4,169,602 as set forth in the previous office action. The rejection of claims 1-17 as set forth in the final rejection has not been sustained.

Claims 26 and 27 are rejected under 35U.S.C. 103(a) as being unpatentable over Heddon 4,169,602. The rejection of claims 2 and 3 as set forth in the final rejection has not been sustained.

Claims 29 is rejected under 305U.S.C. 103(a) as being unpatentable over Heddon 4,169,60 in view of De Vore 2,9069,983. The rejection of claim 5 as set forth in the final rejection has not been sustained.

Claim 40 is rejected under 35U.S.C. 103(a) as being unpatentable over Heddon 4,169,60 in view of Perrier 5,888,142. The rejection of claim 7 as set forth in the final rejection has not been sustained.

Claims 20, 21, 35 and 36 are rejected under 35U.S.C. 103(a) as being unpatentable over Heddon 4,169,60 in view of Lessard 6,645,082 as set forth in the previous office action;

Claims 22 and 37 are rejected under 35U.S.C. 103(a) as being unpatentable over Heddon 4,169,60 in view of Scottman 4,146,223.

Claims 23 and 38 are rejected under 35U.S.C. 103(a) as being unpatentable over Heddon 4,169,60 in view of Sawdust Making 101.

Claims 18-24, 26-29, 31, 32 and 35-40 are rejected under 35U.S.C. 103(a) as being unpatentable over DeVore as set forth in the previous office action and further in view of Heddon 4,169,602 as set forth in the previous office action and further in view of Heddon 5,348,513. The rejection of claims 1-17 as set forth in the final rejection has not been sustained.

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,645,082	Lessard et al.	11-2003
5,888,142	Perrier	3-1999
5,348,513	Heddon	9-1994
4,169,602	Heddon	10-1979
4,146,223	Stottman	3-1979
2,969,983	De Vore	11-1956

<http://www.sawdustmaking.com/About%20Joints/aboutjoints.htm>, Sawdust Making 101 - a guide for the beginning woodworker, about finger joints, 2003.

(9) Grounds of Rejection

Claim Rejections - 35 USC § 112

Claims 7 and 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as set forth in the previous office action;

"In claims 7 and 40, the "remaining sections of the approach section" is inferential and lacking a proper antecedent basis."

Applicant remarks that this phrase does not lack an antecedent because it is first recited in claim 7 and support is in claim 6. Such a view does not overcome the rejection. Claimed is "a prefabricated flooring system" in claim 1 and that it is intended to be "used as a section of an approach section". Nowhere is either "remaining

sections" or an "approach section" being positively recited or claimed in combination. One would have to infer that an approach having a plurality of sections has been previously recited. Yet such is not claimed since the only reference to an approach and any remaining sections is done functionally in recitations as to how the prefabricated flooring system is to be used. This is in contrast to structurally and positively reciting these limitations in combination as a part of the claimed invention. Quite clearly, the Examiner's position is that the claims do not positively recited that the prefabricated flooring system to include either an approach or a plurality of sections and that any references to such are inferred or functional at best. As such, this grounds for rejection remains.

Claim Rejections - 35 USC § 102

Claims 18, 19, 24, 28, 31, 32, 39 and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Heddon 4,169,602 as set forth in the previous office action.

As to claims 18, 24, 30 and 39 the flooring system used in an approach is shown making up elements 20, 26 and 28. The thickness of the approach is considered to be approximately the same as described at col. 6, lns. 29-33. The bowling alley of Heddon is considered laminated as called for by claims 25, 28 and 40 and as described in the abstract at line 3. Elements 20 and 26 are approximately equal to the width of a bowling alley as called for by claim 19. Element 28 is a filler section to extend past the gutters and ball return of the alley. Known is that a bowling lane is between 41 and 42 inches and as such the approach of Heddon consisting of 20, 26 and 28 is wider as shown in fig. 1. As to claim 6, Heddon shows the preformed section 20 and 26 used as a section of an approach. As to claims 8 and 31, finishing the lane is shown at col. 7, ln. 14. Curable polyurethanes are well known and considered inherent in Heddon. A fiberboard OSB underlayment as called for by claims 9-12 and 32 is shown at 50 which is bonded to the boards (col. 5, ln. 42). An integrated foul line as called for by claims 14 and 34 is shown at 18 that is bonded to a groove as shown in fig. 12 (col. 5, ln. 21) as called for by claim 15. The foul line is considered to be a block as shown in fig. 12 and called for by claim 16."

Applicant argues that claim 18 is not shown in that Heddon shows his module 20 as being the same size as modules 10, 12, 14 and 15. First, size is not a limitation in the claim and second no limitation on what one considers to be a gutter area is made in the claims. Here, where the limitation of claim 18 are not considered to distinguish over Heddon since his approach section is considered to fill "an area of the bowling lane in addition to the gutter area" as shown in fig. 1 and as called for by the claims.

With respect to claim 24, the term laminated flooring evaluated for its plain meaning. 1. to cover something with a thin layer, 2. bond layers together 3. a material made up of bonded layers. Where Heddon is considered to show layers bonded together such as 50 and 52 and in fact uses identical term "laminated" (col. 5, ln. 37) to describe its construction, this new limitation added to the claim fails to clearly distinguish over the applied art.

Claim Rejections - 35 USC § 103

Claims 26 and 27 are rejected under 35U.S.C. 103(a) as being unpatentable over Heddon 4,169,602 as set forth in the previous office action;

"Heddon does not mention the thickness of the boards. To have made the boards between $\frac{3}{4}$ and $2\frac{3}{4}$ inches would have been an obvious matter of choice depending upon the desired costs to manufacture, durability and weight. Such a thickness has not been shown to be critical to applicant's claimed invention by solving any particular problem or producing any unexpected results."

With respect to this ground for rejection of claims 26 and 27 under 103 of Heddon, applicant argues that his claimed smaller thickness saves cost. However, the savings in materials by making a product thinner is expected. One skilled in that art

would be aware of other known and expected advantages that would follow such as lighter during installation, and cheaper shipping. This is not considered a patentable advance in bowling lane as much as it is design consideration made by one skilled in the art. Quite clearly too thin would reduce durability. It is the optimization of these variables that are considered obvious to one of ordinary skill in the art.

Claim 29 is rejected under 305U.S.C. 103(a) as being unpatentable over Heddon 4,169,60 in view of De Vore 2,969,983 as set forth in the previous office action;

"While Heddon does not discuss the type of adhesive used to bond the boards, DeVore teaches in bowling alleys that any suitable adhesive may be used (col. 4, ln. 55). As such to have selected a suitable adhesive such as those called for in claims 5 and 29 would have been an obvious matter of selecting a known adhesive suitable for its intended use. See *In re Leshin*, 227 F.2d 197, 1205 USPQ 416 (CCPA 1960) (selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious). Applicant has not shown where the adhesives claimed solve any particular problem or produce any unexpected results."

Claim 40 is rejected under 35U.S.C. 103(a) as being unpatentable over Heddon 4,169,60 in view of Perrier 5,888,142 as set forth in the previous office action.

"Heddon describes his approach as a "smooth wooden surface" (col. 4, ln. 46) and fails to mention the use of synthetic boards. Perrier teaches that the bowling lanes may be made of wood or synthetic material (col. 3, ln. 44). To have used synthetic boards on the approach section of Heddon would have been obvious in order to take advantage of the known properties of synthetic materials. Such a selection has been held obvious in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945)."

Claims 20, 21, 35 and 36 are rejected under 35U.S.C. 103(a) as being unpatentable over Heddon 4,169,60 in view of Lessard 6,645,082 as set forth in the previous office action;

"Heddons invention does not use nails or screws. However, the use of screws and plugs to secure bowling lane sections such as in Heddon is old as taught by Lessard. To have used the combination of drilled holes, screws and plugs in Heddon as taught by Lessard would have been obvious in order to replace one known method of mounting bowling lane panels for that of another."

Claims 22 and 37 are rejected under 35U.S.C. 103(a) as being unpatentable over Heddon 4,169,60 in view of Scottman 4,146,223 as set forth in the previous office action;

"Heddon does not discuss range finders. Such are old and well known as taught by Scottman who teaches adding wooden bolts or dowels 41 which are used for positioning and targeting of the ball. To have included wooden dowel range finders in Heddon would have been obvious in order to help a player's aim and delivery."

Claims 23 and 38 are rejected under 35U.S.C. 103(a) as being unpatentable over Heddon 4,169,60 in view of Sawdust Making 101 as set forth in the previous office action;

"Heddon does not discuss any wood joinery in his patent. However, the use of finger joints in the art of wood working is well known in order to attach two pieces of wood together. To have used finger joints on the abutting boards of Heddon would have been obvious in order to join two shorter boards together."

Applicant does not argue this grounds for rejection or comment on the teachings of Sawdust Making 101.

Claims 18-24, 26-29, 31, 32 and 35-40 are rejected under 35U.S.C. 103(a) as being unpatentable over De Vore as set forth in the previous office action and further in view of Heddon 4,169,602 as set forth in the previous office action and further in view of Heddon 5,348,513 as set forth in the previous office action.

"As to claims 9, 24, 25, 30, 37 and 38, DeVore shows wooden boards 47 held together by adhesive "between the contacting surfaces" (col. 5, ln. 59). As to claim 9, an underlayment 41 is shown. DeVore teaches assembling the boards onsite and using a bar clamps 57 and 58 until the adhesive has cured (col. 5, ln. 34). He does not mention the building of any of the components in a factory. Heddon teaches in bowling lanes constructed of hardwood strips such as that of DeVore that they may be prefabricated or "fabricated in modules at a manufacturing facility" (abstract, ln. 1) to reduce time and cost (col 1, ln. 15)

While DeVore fails to mention making portions or the entire assembly of his invention offsite and bringing these components to a point of installation, doing such is considered old and well known in order to control quality, improve efficiency and save installation time. Heddon teaches prefabricating bowling lanes. To have prefabricated the assembly of DeVore by gluing the board to the base offsite in component sections would have been obvious in order to reduce the amount of time it would take to install onsite."

As to claim 24, it was remarked in the previous office action that;

"As to claims 6, 24, 31, 39 and 40, DeVore discloses a "bowling alley" and approach area 10. DeVore does not specifically intend his invention to only be applied to the part of the bowling lane upon which the ball is intended to be rolled towards the pins. In fact his disclosure is broad pertaining to, "construction... in securing of the bowling alley surface boards" (col. 1, ln. 17), which includes the approach area as shown by 10 in his fig. 1. We can further see from U.S. Patent 7,022,024 that the term "bowling lane" applies to all sections of the lane including the "approach area, a pin deck area and a lane area" (col. 1, ln. 53). Likewise, see 6,988,953, col. 1, lns. 11-19 and 6,645,082, col. 1, ln. 10. DeVore discloses the use of adhesive "between the boards" as it penetrates during the building process. Col 5, Ln. 57+ goes into more detail that "the adhesive...is to a certain extent forced between the contacting surfaces of said boards..., not only securing the contacting lower surfaces of the alley boards but likewise and simultaneously securing the said boards to one another".

The size of the boards in claims 26 and 27 is considered an obvious matter of choice and has not being shown to be critical. See In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984). The size of the approach as called for in claims 18 and 28 is considered an obvious matter of choice (*Gardner v. TEC Systems*. DeVore teaches the use of any suitable adhesive (col. 4, ln. 55) to meet the limitations of claim 29. As to claim 40, the use of synthetic materials in place of wood is well known. As to claim 32, the use of fiberboard, such as OSB Oriented Strand Board in place of plywood is old and well known.

As to clams 20, 21, 35 and 36, counter sunk screws and plugs are well known mechanical fasteners. To have replaced the adhesive of DeVore with that of a mechanical fastener would have been obvious to have replace one known mechanical fastening expedient for that of another. The use of dowels for range finders as called for in claim 22 and 37 is old and well known. As to claim 23, the use of mortise and finger joints to connect two wood elements together is considered to be old and well known. DeVore shows the use of such dovetails 17 and 18 (col. 2, lns. 51-59) that are considered "interleaved finger joints" along a short side of adjacent floor sections. The interpretation of the dovetails of DeVore meeting the limitations of "finger joints" is supported by "Wikipedia, the free encyclopedia" http://en.wikipedia.org/wiki/Finger_joint (*attached here*) where a finger joint is described as "much like a dovetail". To have use a finger joint in DeVore would have been obvious in order to obtain a stronger joint." DeVore clearly contemplates the use of fasteners as his "sub-baseboard 33 is secured

along its edges to each of the transverse beams 25 by means of screws" (col. 4, ln. 24). Pre-drilling for screw fasteners is old, well known and not considered a patentable advance. With respect to the "materials not invented" at the time of DeVore, it is known to be obvious to use a material to take advantage of its known properties. To apply newly available materials for their intended purpose to old products is not inventive and has been held obvious. "

(10) Response to Argument

(A)

Rejection of Claims 7 and 40 under 35 USC 112

Appellant restates MPEP §2173.02 and examiner's explanation for the rejection in the final rejection to which no response is deemed necessary.

While appellants statement that "claim 7 depends from claim 6 which, in turn, depends from claim 1" is clearly not disputed, his statement that "claim 6 further defines the prefabricated preformed section as including 'an approach section of a bowling lane'" is incorrect. As set forth above in the rejection, claim 6 merely states a function of intended use for the preformed section to be "used as a section of an approach section". This is NOT a positive recitation of an "approach section". It is a recitation of intended use for a preformed section of the claimed "prefabricated flooring system". Turning to claim 7, it positively refers to the "remaining portions of the approach section". Here where an approach section is not considered to be positively recited as part of the claimed combination in claim 6, it further fails to recite that such comprises sections. As such any reference to the approach section which is not positively recited

and its comprising sections that are not previously recited at all would render the claim indefinite. Here one cannot be certain if the combination elements in the claimed "prefabricated flooring system" includes or requires an approach section comprising section and as such is indefinite.

Appellant's argument that the "remaining portions" are provided in a "structural context" is off point for the rejection. Here one cannot determine to what "remaining portions" of the approach section the claim limitations may be addressing. At best, one would have to assume that the approach is made up of a plurality of section and any section that is not considered to be the approach section would be synthetic boards. It is this type of speculation about the scope of the claims that render them indefinite.

At the bottom of pg. 7, appellant argues that the "remaining portions" and "approach section" are positively recited without showing how such functional limitations make it clear that these elements are part of the claimed combination. As set forth in the grounds for rejection and above, the examiner disagrees with applicant's position and this ground for rejection should be affirmed.

It is off point with the grounds for rejection where appellant argues that the specification also clearly defines the approach section and the remaining sections. The claims were not rejected for failing to find support for the terms in the specification. Instead, the rejection is for indefiniteness and indeterminable if the elements being positively referred to were even positively recited earlier on in the claim as a required part of a combination of elements. Appellant's selections of the specification

reproduced on pg. 8 do not overcome the indefinite problems of the claims. As such this argument is unpersuasive.

Claim 40 contains recitations similar to that of claim 7 and contains the same indefiniteness problems as set forth above. Claim 39 from which claim 40 depends is somewhat different than that of claim 6 in that instead of reciting functionally that the preformed sections are "used as a section of an approach section", it recites more positively that the preformed section "is at least a section of an approach area". Even so, this does not provide an antecedent for the "remaining portions of the approach area" called for in claim 40. Once again, an approach area of a plurality of sections is not part of the claimed combination. Since claim 40 fails to used either and indefinite or definite article with respect to "remaining portions" one cannot determine if one is referring to a previous recitation or "any remaining portions" in general. As such, the Board should consider these claims together and find that rational for affirming the rejection of claim 7 also stand for that of claim 40.

(B)

Rejection of Claim 24 and its dependent Claims under 35 U.S.C. 112, 1st Paragraph

The rejection of claims 24 and its dependent claims are rejected under 35 U.S.C. 112, first paragraph has not been sustained in view of paragraphs [0015] and [0016] of the specification As such applicant's remarks in his Brief are considered moot.

(C)

The rejection of claims 1, 4, 6, 8-12, 15-19, 24, 28, 31, 32, 39 and 40 are rejected

under 35 U.S.C. §102(b) for being anticipated by U. S. Patent No. 4,169,602 issued to Heddon.

The rejection of claims 1-17 has not been sustained. As such applicant's remarks thereto are deemed moot and no response is deemed necessary. Upon reconsideration of applicant's remarks and review of the art of record, Heddon 4,354,678 in fig. 15 appears to show the closest piece of art with respect to a foul line positioned in a routed out grove at the end of an approach panel. However, he lacked that adhesive. In fact, he discloses at col. 7, ln. 58 that "gluing or other bonding procedures (of the foul line in the groove) are rendered unnecessary." While he appears to recognize that adhesives could be used the only teaching that such would be required appears to come from applicant's invention. While one could have used adhesive, the examiner does not feel sufficient motivation would exist to one skilled in that art since it would have been unnecessary and there is no evidence of record that any problem existed with the foul line arrangement of '678.

Claim 18

Appellant argues in favor of claim 18 based upon a narrow view of the claim not supported by its limitations. It only requires the approach section to fill "an area of the bowling lane in addition to gutter area". No limitations in the claim constrain what is considered to be gutter area. Most broadly such term can reasonably be interpreted by its plain meaning be areas around or adjacent to the gutters. No explicit definition of the term in the specification appears to exist. Appellant argues that the approach lane module 20 of Heddon is of the same size as the remaining modules 10, 12, 14, 16 and

specifically designed to be the same size (width) as the remaining modules 10, 12, 14, 16. However, this argument is not commensurate with the scope of the claim since size in general is not being claimed. The only requirement is that the approach section fills some area of the bowling lane in addition to something determined to be "gutter area". While it appears appellant wishes one to believe that "gutter area" is an area sized to extend wider than the remaining modules, such a view is not supported by the language of the claim. Additionally, appellant's discussion of the approach fill means 28 of Heddon do not teach away from what is being claimed where his preformed section of wooden boards 16 fill an area adjacent to the gutter meeting the broad limitations of the claims. As such, Heddon's approach module extending adjacent to the gutters as shown in fig. 13 meets these broad limitations and the rejection of this claim should be sustained.

To respond to examiner's position, appellant submit that the bowling lane and gutter area are well defined terms to those of skill in the art. However, he points to no authority to support this assertion. The examiner disagrees and, having worked in the art for more than 20 years, does not afford any meaning to the terms beyond their ordinary meaning. Here a gutter area is most broadly any area about the gutters and a bowling lane can most broadly be used to refer to most elements necessary to the game of bowling. For example, one may refer to a bowling lane to include the deck, ball return, pinsetter, masking unit and/or so forth. As such this argument of appellant is not persuasive and limitations that are not in the claims should not be read into them.

Even if one could possibly construe the claims as narrowly as wished by appellant, the arrangement of an approach panel extending in width to the outer edges of the gutters is well known for example in Fig. 2 Heddon 5,348,513 or Fig. 2 of Hixson 5,540,624 both of record.

Claim 24

Appellant argues that Heddon does not show a laminate floor and that none of his modules can be considered a laminate floor. This is untrue since such is disclose on ln. 3 of the abstract and at col. 1, ln. 18 where Heddon describes his bowling lanes as a "laminated hardwood lane deck". He explicitly recites at col. 2, ln. 62 his "modules having laminated hardwood panels". Appellant tries to misguide the Board to define laminate floors as though there is a single accepted definition known in the art. However, applicant's interpretation is inconsistent with the art as shown above where Heddon considers his structure to be a laminated floor for a bowling alley. More accurately, the term "laminate" is more generic and has a plain meaning including any structure having one or more layers of materials.

Where appellant argues that Heddon does not mention that the approach section has a thickness approximately equal to a bowling lane, this is not supported by a thorough reading of the reference. From fig. 4 one can see that the thickness of the approach is approximately equal to that of the bowling lane. As such the limitations of the claim are considered clearly met.

Where appellant points to pages 9 and 10 of his specification, such does not remedy the lack of any specific structure being recited in the claims with respect to what

is included in a laminated floor of a bowling alley. Note there is no explicit definition of the term used in the specification but merely alludes to the fact that the bowling lane "may be a high pressure laminate flooring system". As stated above, appellants conclusions that, "use of wooden planks, as is known to those of skill in the art, would not be considered a laminate" is not supported by the teachings of Heddon. Therein his prior art background he refers to the "prefabricated laminated sections" of Grawey 2,788,973 at col. 1, ln. 41, "laminated hardwood bowling lane" and "laminated hardwood deck" of DeVore 2,969,983, "laminated sheets" of Green 3,014,722 and so forth. As such it is clear that the bowling lane of Heddon meets the limitations of a "bowling lane, which is a laminate floor" and this grounds for rejection should be sustained.

Where appellant argues that "there is no indication, whatsoever, that the modules of each of the lane sections of Heddon are designed differently than that of the approach module", no limitations in the claim requires such. It only requires that the bowling lane be considered a laminate floor. As such this argument is not persuasive.

Dependent Claims 19, 28, 31, 32, 39 and 40

Claim 16 and 17

Applicant's remarks with respect to these claims are considered moot since the ground for rejection to claim 1 from which the depend has not been sustained.

Claim 28

Claim 28 recites:

Appellants submit that Heddon does not show a prefabricated approach section that has a width greater than the bowling lane. However, this conclusion is not

commensurate with the scope of the claim. First it recites using open language that that the prefabricated approach section comprises a plurality of wooden boards bonded together sided by side. Heddon shows his prefabricated approach section comprising elements 20, 26 and 28 to be wider than bowling lane section 16 as shown in fig. 1. Here Heddon's approach section clearly comprises a plurality of wooden boards bonded sided by side in elements 20 and 26 and one that is wider including elements 28. It is irrelevant to the scope of claim 28 that Heddon refers to sections 28 as an approach fill means since the limitations of the claim are recited using open language. As such they fail to clearly distinguish over the applied art and the grounds for rejection should be sustained.

Claim 34

Appellant remarks with respect to this claim have been persuasive and this grounds for rejection has not been sustain.

(D)

Claims 26 and 27 are rejected under 35 U.S.C. §103(a) for being unpatentable over Heddon.

First the rejections of claims 2 and 3 have not been sustained since they depend from claim 1 no longer rejected. Appellants disagree with the Examiner and states that the Examiner has not set forth any arguments that the dimensions of the claimed invention are recognized as a result-effective variable, i.e., a variable which achieves a recognized result and concludes that the Examiner has improperly rejected

the claims. Appellant's arguments are off track. Here the basis of the rejection is that changes in size have been held not to be patentable. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. Additionally, nowhere in his arguments does applicant submit a response to show where his claimed thickness is critical. Note that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In *re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). As is here with the instant issue before the Board, it is recognized that differences will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such critical. As such, this grounds for rejection must be sustained.

(E)

Claim 29

The rejections of claim 5 has not been sustained since it depends from claim 1 no longer rejected. Appellant submits that this rejection is in error because they do not agree that DeVores shows the features of the claimed invention. Appellant's logic is off track since Heddon shows the use of adhesive between the boards but fails to call it by name. DeVore was applied since he teaches in bonding laminated bowling panels that

"any suitable adhesive may be used." Further it has been held that the selection of a known material for its intended purpose would have been obvious. Lastly, in KSR, 550 U.S. at ___, 82 USPQ2d at 1391 the substitution of one known adhesive like that shown by Heddon for another to obtain predictable results and that it would have been obvious to try other known adhesives to determine which would suitably bond the boards of Heddon in a bowling environment has been held an obvious endeavor for one of ordinary skill in the art. Appellant has not shown where any of the adhesives being claimed is critical by solving any particular problem or producing any unexpected results. Lastly, it is immaterial to patentability where applicant states that it has not been establish that any of the claimed adhesives were on the market at the time of the prior art. Applying a new adhesive for its intended purpose in place of adhesive in the prior art would have been obvious absent some unexpected results.

(F)

Claim 40

The rejection of claim 7 has not been sustained in view of it dependency upon claim 1, no longer rejected. Appellant believes this rejection to be in error because Pierre is silent at to the composition of the approach section. Here applicant only discusses Pierre and not the combination of the applied references in view of the claim. First, it is the claim that only requires "remaining portions of the approach area" to be "synthetic material or residual wood". Looking to Heddon one can see where the panels 28 of fig. 1 meet the limitations of "remaining portions of the approach area" and that these modules are made of a "hardwood panel" (col. 6, ln. 26) which is considered to

meet the limitations of "residual wood". Even though a synthetic material is recited in the alternative, Pierre was applied in the alternative to teach that the film of element 58 can meet the limitation of "remaining portions of the approach area" and that it is considered a synthetic material. To have applied a remaining portion of a synthetic layer of film to Heddon as taught by Pierre would have been obvious as a "protective coating" (col. 4, ln. 51). Appellant's argument that Pierre is not directed to an approach is not shared by the examiner. From fig. 1 he includes the approach area 38 as being within the scope of his invention. Since such an alternate interpretation of the art reads on the claimed invention, this claim 40 fails to distinguish over the applied art.

(G) & (H)

Claims 20, 21, 35 and 36 and Claims 22 and 37

Appellant provides no separate arguments for these claims. As such this grounds for rejection should be sustained.

(I)

Claims 18-24, 26-29, 31, 32

and 35-40

Here the rejection of claims 1-12 and 34 has not been sustained and the remarks directed thereto are considered moot.

Claim 18

Appellant argues that there is no teaching in any of the references to show that a prefabricated sectioned approach section totally fills an area of the bowling lane in addition to gutter area. One can see this remark as untrue when viewing fig. 1 of

DeVore and fig. 2 of Heddon '513 which teaches the dimensions of the approach to extend to the outer edges of the gutters. As such this grounds for rejection should be sustained as being fairly taught by the applied art.

Claim 24

Appellant defers to his previous arguments made with respect to claim 24. However, they are no more persuasive here than they were before. In making this rejection it is clear that DeVore clearly shows the bowling lane having an approach 10 and plurality of wooden boards. The Board decision of 3/23/09 stated that he lacks showing the approach being "prefabricated". Additionally he does not describe his panel as a "laminated" or the relative thickness of the sections of his alley. To address those deficiencies, Heddon '602 clearly teaches the benefits of prefabricating a panel such as DeVore offsite. He additionally provides an explicit teaching that DeVore shows "laminated hardwood bowling lane" (col. 1, ln. 61) and teaches in fig. 4 where the approach of a lane is of equal thickness to the laminated sections of the alley. With respect to the thickness DeVore does not appear to contain a discussion or show a side cross-section view of his lane sections. Even so, the necessity to keep the upper surface of a lane level fairly suggests to one of ordinary skill in the art that the sections are inherently of an identical thickness. Here the claiming of an unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Extrinsic evidence that this is true of DeVore is found in the teachings of Heddon '602 as set forth above. While it is true that Heddon '513 is not necessary to support an

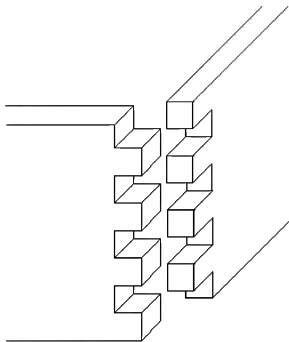
affirmation of this grounds for rejection since it was originally applied to the rejection of claim 1 (no longer sustained) pertaining to a bonded foul line, it does bolster it by supporting the extrinsic evidence in the teachings of '602 and showing that it is well known to have an approach sized wider than the bowling lane to extend to the outer edges of the gutters. With respect to Heddon '513 appellant distorts a single embodiment to support his cause while failing to consider what is fairly taught. In contrast, he clearly discloses approach section 10 and lane panel 16 in fig. 3 where one can observe that such are of equal thickness. It is clear from the combined teachings that the thickness of a section of the bowling alley is a variable of the relative height of the substrates and the necessity of the bowling surface to be at the same level and seamless. Alternatively where one does not view DeVore to inherently show the thickness of the approach to be the same as the bowling lane, Heddon '602 teaches that such a relationship between the sections of the bowling alley would have been obvious so that its upper surfaces match to provide smooth rolling of the bowling ball thereon. As such, this claim fails to distinguish over the applied art and should be affirmed.

Appellant remarks that DeVore does not describe an approach which is untrue since such is clearly shown in element 10 of fig. 1 and at col. 2, ln. 39. Appellant additionally mischaracterizes Examiner's position with respect to the terms approach section and bowling lane. A bowling lane is often a more general term used to refer to all floor components used to bowl where an approach is generally a more specific term to the section used by a player while delivering the ball. This distinction is shown by

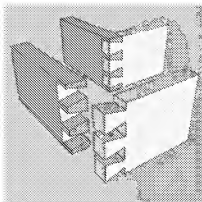
U.S. Patent 7,022,024 where the term "bowling lane" applies to all sections of the lane including the "approach area, a pin deck area and a lane area" (col. 1, ln. 53). Likewise, see 6,988,953, col. 1, lns. 11-19 and 6,645,082, col. I, ln. 10. As such, any discussion in the prior art pertaining to a bowling lane or alley does not necessarily exclude the approach section of the lane. As such, the discussions of the "alley" in DeVore are submitted to suggest the entire bowling surface including the approach as shown in his fig. 1. As such, appellant's remarks fail to show where the examiner is in error or unreasonable in his interpretation of the applied art and this grounds for rejection should be sustained.

Claim 38

Applicant argues that the dovetails of DeVore (col.2, ln. 51) are not the same as the interleaved finger joints being claimed. First his specification provides no explicit definition for the term finger joint nor is any other structure provided in the claims. While the term is generally used in wood joining, it is generally made by cutting a set of complementary rectangular cuts into to pieces of wood as shown below;



These complementary rectangular cuts are the same as that shown by joints 17 and 18 of DeVore. Quite clearly his joint is the same as the finger joint defined above and clearly meets the limitations of the claims. While it may be true that DeVore uses the term "dovetail" to describe his joint, such appears to be more descriptive or ill-defined and does not follow what is ordinarily known to wood joining where a dovetail comprised pins and tails having a trapezoidal shape as shown below;



If anything, with respect to the terms used in wood joinery, his use of the term "dovetail" to describe his joint 17 and 18 is more aptly a finger joint as shown in the first illustration above. As one can see from the above, Appellants belief that his claimed finger joint is not the same as DeVore does not agree with the ordinary meaning of term and the teachings of the applied art.

Additionally, appellant mischaracterizes DeVore by stating that the short edges of each plank of wood are merely being adhered to one another by an adhesive to an underlayment. DeVore clearly discloses that adhesive is "forced between the contacting surfaces of said boards upon the placement thereof...securing the said boards to one another" (col. 5, ln . 58). Additionally, appellant remarks that the joints of DeVore are "are flat edges, abutting one another. Instead, the interleaved fingers of the present invention" does not match what is being claimed. The shape of the finger joints, "flat" or otherwise, is not recited in the claim. From the broadest reasonable interpretation of the limitations recited in the claim and meaning to one of ordinary skill in the art, DeVore shows the claimed "finger joint" and this rejection must be sustained.

Dependent Claims 19-23,

26-29, 31, 32 and 35-37, 39 and 40

These claims stand or fall with the above claims since no separate arguments with respect to them has been provided.

Claim 16 and 17

This grounds for rejection and the remark thereto are moot since the grounds for rejection of independent claim 1 from which they depend has not been sustained.

(11) Related Proceeding(s) Appendix

The Board previously rendered a decision on this application on 3/23/09. The Board reversed giving heavy weight to the term "prefabricated" used in the preamble. Since the examiner held strong belief that the prefabrication of an apparatus was considered well known, especially since prefabricated bowling panels were art of record but not applied in the previous grounds for rejection, the examiner reopened prosecution to apply the known art.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/William M Pierce/

Primary Examiner, Art Unit 3711

Conferees:

/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711

/XUAN M. THAI/

Supervisory Patent Examiner, Art Unit 3715